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Paul H. Robb

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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/732,008	<b>Applicant(s)</b> ROBB, PAUL H.	
	<b>Examiner</b> KELLY CAMPEN	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

*The following is in response to the request to reopen prosecution and the amendments to the claims filed 2/9/2009 in response to the new grounds of rejection in the Examiner's Answer dated 12/9/2008. Claims 1-41 are pending.*

### *Specification*

The abstract of the disclosure is objected to because it includes that which may be implied (for example, "the invention provides", and see below for further explanation).

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

**The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In the instant abstract, the language "the invention provides" should be avoided.**

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims there is recited terms that are indefinite because there is no clear definition of the meets and bounds of the term. There terms include: “collaborate”, “enabling”, and “to interact”.

In dependant claims there is recited: “events” and “actions” which are also terms that are indefinite because there is no clear definition of the meets and bounds of the term.

The terms “client” and “participants” are confusing since the relationship between the two is not recited (i.e.: are the participants clients of the client?).

All claims will be examined as best understood.

All dependant claims that are not vague and indefinite are rejected because they encompass a rejected independent claim.

While applicant claims to have amended to overcome this rejection, Examiner disagrees and the rejections are maintained.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-19 and 39-41 recite a process comprising the steps of enabling and storing. Based on Supreme Court precedent, a proper method/process must be tied to a machine or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the use of a particular machine does not impose a meaningful limitation on the claim's scope by being present in more than a mere field of use limitation (see below) and the use of the particular machine does not involve more than insignificant extra solution activity, the method is not considered a patent eligible process under 35 U.S.C. 101.

A mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. In addition, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claims 20-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter (a system with a hub). Code and software – i.e., computer program - are nonstatutory subject matter. Computer programs claimed as

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computer listings per se, i.e., the descriptions or expressions of the programs, are not “physical things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. The claim appears to be claiming functional descriptive material (code per se) as set forth in MPEP 2106.01. In addition, it appears that the claim is trying to claim the code on a signal. Putting code on a statutory type of medium (the typical computer readable medium, like a hard drive or CDROM) is statutory, but a signal is not currently a statutory type of medium. See *In re Nuijten*, 84 USPQ2d 1495 and the rationale therein.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 09/877,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

A “forum” encompasses a “collaboration tool”, “defining a scope of authorization” encompasses “encryption”, and a “library of resources” encompasses a “database”.

**This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.**

Although the appellant disagrees with the provisional double-patenting rejections set forth by the Examiner, the Appellant did not address these provisional rejections in the Appeal Brief. Rather, the appellant states the appellant will file a terminal disclaimer upon the indication of allowable subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-17, 19-26, 28-36, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al.

Zucknovich et al discloses a method for providing a tool with which a client and one or more participants may interact. A client authorizes one or more participants to access client data (col 1, lines 50-56). The client submits client data to the tool (col 5, lines 60-67). The client submits one or more requests for one or more services to the tool (col 6, lines 25-30). The client interacts with one or more participants through the tool, wherein interaction among participants comprises exchange of client data (col 87, lines 14-50). The participants may be financial advisors (col 5, lines 55-56). The participants comprise one or more entities authorized by the client to participate in the tool, wherein the client also defines the scope of authorization for each participant (col 6, lines 25-30).

The client data comprises financial documents as a work product (col 2, lines 41-50). The client is enabled to define one or more triggering events / alert mechanisms for notifying the client of an occurrence (col 7, lines 32-37). There is enabled the client to access a client history database wherein the client history database maintains information related to previous updates (col 83, lines 26-45).

Zucknovich et al does not use the word “collaboration” to describe their tool.



It would have been obvious to one with ordinary skill in the art to include “collaboration” as describing the tool to Zucknovich et al because Zucknovich et al. teaches that research providers require interaction with those who desire their work product (col 1, lines 39-44).

Claims 8, 18, 27, 37, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al as applied to claims 1-7, 9-17, 19-26, 28-36, 38 above, and further in view of Day et al.

Zucknovich et al does not disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data.

Day et al discloses disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data ( col 3, lines 45-67; col 4, lines 1-25).

It would have been obvious to one with ordinary skill in the art to include participant input wherein participant input comprises one or more or edits, analysis and comments related to client data because Day et al teaches collaborative efforts require edits, analysis and comments (col 3, lines 45-64; col 4, lines 6-25), and Zucknovich et al teaches correction for inaccuracies of client data (col 1, lines 62-67; col 2, lines 1-25) in addition, the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

***Response to Arguments***

Applicant's arguments filed 2/9/2009 have been fully considered but they are not persuasive.

In response to applicant's argument against the 35 USC 112 second paragraph rejections, regarding "collaborate", "enabling", "to interact", "events", and "actions" these terms have relative meaning. What may be considered such to one may not be considered such to another. There are several 'participants' making the claims vague and overly broad in that it is unclear how the client differs and relates to each participant. In returning to the specification to clarify, the issue is made even more confusing as it appears that the terms 'client' and 'participant' are interchangeable. Additionally, applicant has not invoked 112 6<sup>th</sup> paragraph to assist in defining the terms and the metes and bounds of the invention claimed.

Specifically as to applicant's argument that it is "clear from the plain language of the claim" while the claim is unclear in that lines 2-3 of claim 1 refer to a financial services client and one or more financial services provider participants but lines 4-6 refer to "enabling authorization of one or more participants to access client data" and "enabling a client or participant to submit client data". It is unclear if these participants and clients are financial clients and participants or they are additional to the financial clients and participants referred to in lines 2-3 of the claim. Examiner is using claim 1 as an example while the issue also exists in the remaining claims as well.

Regarding the 35 U.S.C 103 rejection of record, the "interaction among the participants" and "an exchange of client data among the participants" is encompassed by

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what is disclosed by Zucknovich. Zucknovich discloses data exchange via the Internet or other network device to participants (researchers) and interaction in the form of discussing the research reports. The terms “interact” and “exchange” are given the broadest possible meaning.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that neither Zucknovich et al. nor Day et al. are analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Zucknovich et al. is both in the field of applicant's endeavor and is reasonably pertinent to the particular problem with which the applicant is concerned. Zucknovich et al. is concerned with distributing information to investors from a client. Day et al. is concerned with network based document (information) review tools via a computer network. Submitting information is analogous to submitting client data. Both involve an exchange of data.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/  
Primary Examiner, Art Unit 3691